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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,470	11/20/2003	Narayanan Hariharan	D0026 DIV	1042
23914	7590	03/10/2006	EXAMINER	
LOUIS J. WILLE BRISTOL-MYERS SQUIBB COMPANY PATENT DEPARTMENT P O BOX 4000 PRINCETON, NJ 08543-4000			ROOKE, AGNES BEATA	
		ART UNIT	PAPER NUMBER	
		1653		
DATE MAILED: 03/10/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/718,470	HARIHARAN, NARAYANAN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Agnes B. Rooke	1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 9 and 20 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 9 and 20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

**This action is non-final.**

This paper is in response to the communication filed on 12/01/2005. The amendments to the claims filed on 12/01/2005 are acknowledged. Claims 9 and 20 are pending. Claims 1-8, 10-15 and 18-19 are cancelled.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 9 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 9 and 20, it is necessary to provide the full spelling of the name "PPAR $\delta$ ( $\beta$ )."

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 9 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Palmer et al. (WO 01/07066 A2).

Palmer et al. teach a method of administering to the patient an effective amount of an inhibitor of PPAR $\delta$  activity. See Abstract.

On page 24, in Example 3, Palmer et al. teach screening for inhibitors of PPAR $\delta$  activity, where the binding assay is performed, where recombinant PPAR $\delta$  is mixed the radioactive ligand in a presence of a test compound; where the mixture is applied to mixed cellulose filters and the fluid is drawn through the filter; where the radioactivity remaining on the filter will represent ligand bound to PPAR $\delta$ ; and where a decrease in the radioactivity bound will indicate the presence of a competing PPAR $\delta$  compound; and where the assay determines binding properties of the test compound.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Doepper et al. (U.S. 5,847,008).

Doepper et al. teach compositions and methods for the use of the compounds in the treatment of obesity. See Abstract.

In column 20, lines 39-62, the PPAR $\delta$  binding assay is provided where: PPAR $\delta$  samples together with a test compound and a radioactive ligand are prepared; the unbound ligand is removed; centrifugation is performed; and counting a portion of the supernatant and quantification of the compound of interest is performed.

Prior art of interest:

1. Johnson et al., Structural Requirements and Cell-type Specificity for Ligand Activation of Peroxisome Proliferator-activated Receptors, J. Steroid Biochem. Molec. Biol. (1997), 63, no. 1-3, p. 1-8; where they identify certain structural features on PPAR-activating agents that modulate PPAR activation.
2. Wilson et al., J. Medicinal Chemistry, (2000), 43, no. 4, p. 527-550; where general overview of receptors is provided.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Agnes Rooke whose telephone number is 571-272-2055. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

Art Unit: 1653

applications may be obtained from either Private PAIR or Public PAIR. Status information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

*Karen Cochrane Carlson Ph.D*  
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KAREN COCHRANE CARLSON, PH.D  
PRIMARY EXAMINER